

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|                   |   |                           |                  |
|-------------------|---|---------------------------|------------------|
| Applicant(s)      | Matthew Pellegrini et al.   | Examiner:                 | Unassigned       |
| Application No.:  | 10/542,255  | Group Art Unit:           | Unassigned       |
| Confirmation No.: | 5103  | Docket:                   | 1368-8 PCT/US    |
| Filed:            | July 15, 2005   | Int'l. Appl. Filing Date: | January 9, 2004  |
| For:              | METHODS AND SYSTEMS FOR THE IDENTIFICATION OF RNA REGULATORY SEQUENCES AND COMPOUNDS THAT MODULATE THEIR FUNCTION | Dated:                    | December 5, 2007 |

Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

PETITION TO WITHDRAW HOLDING OF ABANDONMENT  
PURSUANT TO 37 C.F.R. 1.181(a)

Sir:

In response to the notice of abandonment mailed November 23, 2007, petition is hereby made to withdraw the holding of abandonment. The following information is tendered in support of the subject petition.

FACTUAL BACKGROUND

Exhibit A is a copy of the notice of abandonment, mailed November 23, 2007, alleging that applicants failed to respond to a Notification of Missing Requirements (Form PCT/DO/EO905), mailed 2/24/2006.

Exhibit B is a copy of the Notification of Missing Requirements, mailed February 24, 2006. This notification stated that the oath or declaration of the inventors was missing, and the

Applicant: Pellegrini et al.  
Application No. 10/542,255  
Docket No. 1368-8 PCT/US  
Petition to Withdraw dated December 5, 2007  
Page 2

applicant must provide the sequence listing in computer readable form. The notification set a time period of two months within which to respond.

Exhibit C is a copy of the applicants' response to the Notification of Missing Requirements, mailed May 23, 2006. The response contained a combined declaration and power of attorney, a copy of the Notification of Missing Requirements, computer readable sequence (submitted on a 3.5" floppy disk), and a petition and fee for a one month extension of time. Accordingly, this response was timely submitted.

Exhibit D is a copy of a Notification of Defective Response (Form PCT/DO/EO/916), mailed March 13, 2007, alleging that the sequence listing in computer readable form was not submitted in compliance with 37 CFR 1.821(e). This notification provided for a non-extendable one month time limit within which to respond.

Exhibit E is a copy of Applicants Response to the Notification of Defective Response, timely mailed on April 12, 2007. The return postcard with the USPTO stamp confirming receipt is on the bottom of the first page. This response contained the sequence on floppy disk and a statement indicating that the sequence listing is identical to the sequence originally submitted and contains no new matter. A review of the record for this application in PAIR shows that this response was not entered into PAIR.

## **DISCUSSION**

At the outset, it is not clear why the Office generated the Notification of Defective Response on March 13, 2007. It appears from our files that our response to the Notification of Missing Requirements, mailed May 23, 2006 was fully responsive.

Applicant: Pellegrini et al.  
Application No. 10/542,255  
Docket No. 1368-8 PCT/US  
Petition to Withdraw dated December 5, 2007  
Page 3

Regardless of the sufficiency of our response of May 23, 2006, when the office did mail the Notification of Defective Response of March 13, 2007, we again fully responded to the alleged deficiencies.

For some reason, however, our response to the Notification of Defective Response, mailed on April 12, 2007 was not entered into PAIR. This undoubtedly is the reason the office generated the notice of abandonment on November 23, 2007, since a review of the USPTO records seems to indicate that applicant failed to respond to the March 13, 2007 notice.

As shown by the copy of the attached postcard, applicants' response to the Notification of Defective Response, mailed with a certificate of mailing on April 12, 2007, was received the USPTO on April 16, 2007. Accordingly, applicants submit that the response was timely made and its absence from the USPTO records is a mistake the USPTO.

### **CONCLUSION**

Applicants respectfully request that the applicants' response to the Notification of Defective Response, mailed with a certificate of mailing on April 12, 2007, be properly entered in the USPTO records and the PAIR system.

Applicants further respectfully request that the Office review the file in this case as properly constructed, and withdraw the Notification of Abandonment issued November 23, 2007. The reason the notice should be withdrawn is that applicants response of April 12, 2007 to the Notification of Defective Response of March 13, 2007 was not entered into the USPTO records in this case, through no fault of the applicant. Applicant's response addresses all alleged deficiencies, so there is no reason to maintain the Notification of Withdrawal.

Accordingly, Applicants respectfully submit that this case is in condition for examination.

Applicant: Pellegrini et al.  
Application No. 10/542,255  
Docket No. 1368-8 PCT/US  
Petition to Withdraw dated December 5, 2007  
Page 4

Since this petition is made under 37 C.F.R. §1.181(a) requesting withdrawal of the holding of abandonment, no petition fee is required. If a petition fee is required, however, the Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. §1.17 and should be treated as a constructive petition for an extension of time in this communication or any future communication pursuant to 37 C.F.R. §1.136.

Respectfully submitted,



Andrew H. Berks  
Reg. No. 36,089

HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791  
(973) 331-1700

## **EXHIBIT A**



UNITED STATES PATENT AND TRADEMARK OFFICE

Exhibit A  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22311-1450  
www.uspto.gov

|  |   |                  |
|--|---|------------------|
| U.S. APPLICATION NUMBER NO.  | FIRST NAMED APPLICANT                           | ATTY. DOCKET NO. |
| 10/542,255   | Matthew C Pellegrini                            | 1368-8 PCT/US    |
| 23869<br>HOFFMANN & BARON, LLP<br>6900 JERICHO TURNPIKE<br>SYOSSET, NY 11791 | INTERNATIONAL APPLICATION NO.<br>PCT/US04/00423 |                  |
|  | IA FILING DATE                                  | PRIORITY DATE    |
|  | 01/09/2004                                      | 01/17/2003       |

CONFIRMATION NO. 5103  
371 ABANDONMENT/TERMINATION  
LETTER



OCU00000026858646

Date Mailed: 11/23/2007

**NOTIFICATION OF ABANDONMENT**

The United States Patent and Trademark Office in its capacity as a Designated / Elected Office (37 CFR 1.495) has made the following determination:

- Applicant has failed to respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed 02/24/2006 within the time period set therein.

Therefore, the above identified application failed to meet the requirements of 35 U.S.C. 371 and 37 CFR 1.495, and is ABANDONED AS TO THE UNITED STATES OF AMERICA.

TERRY M JOHNSON VESSELS

Telephone: (703) 308-9140 EXT 221

## **EXHIBIT B**



UNITED STATES PATENT AND TRADEMARK OFFICE

8xh77 B  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Washington, D.C. 20231-1450  
[www.uspto.gov](http://www.uspto.gov)

|                               |                       |                  |
|-------------------------------|-----------------------|------------------|
| U.S. APPLICATION NUMBER NO.   | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
| 10/542,255                    | Matthew C Pellegrini  | 1368-8 PCT/US    |
| INTERNATIONAL APPLICATION NO. |                       |                  |
| PCT/US04/00423                |                       |                  |
| LA. FILING DATE               | PRIORITY DATE         |                  |
| 01/09/2004                    | 01/17/2003            |                  |
| CONFIRMATION NO. 5103         |                       |                  |
| 371 FORMALITIES LETTER        |                       |                  |
|                               |                       |                  |
| *OC000000018110117*           |                       |                  |

Date Mailed: 02/24/2006

**NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)**

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Indication of Small Entity Status
- Copy of the International Application filed on 07/15/2005
- Preliminary Amendments filed on 07/15/2005
- Information Disclosure Statements filed on 07/15/2005
- Biochemical Sequence Listing filed on 07/15/2005
- Small Entity Statement filed on 07/15/2005
- Request for Immediate Examination filed on 07/15/2005
- U.S. Basic National Fees filed on 07/15/2005

The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date.
- To avoid abandonment, a surcharge (for late submission of filing fee, search fee, examination fee or oath or declaration) as set forth in 37 CFR 1.492(h) of \$65 for a small entity in compliance with 37 CFR 1.27, must be submitted with the missing items identified in this letter.

**SUMMARY OF FEES DUE:**

Total additional fees required for this application is **\$-35** for a Small Entity:

- **\$65 Surcharge.**

- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

(A previous payment of \$100 will be applied to the additional fees indicated above.)

Applicant is cautioned that correction of the above items may cause the specification and drawings page count to exceed 100 pages. If the specification and drawings exceed 100 pages, applicant will need to submit the required application size fee.

For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:

- For Rules Interpretation, call (571) 272-0951
- For Patentin Software Program Help, call Patent EBC at 1-866-217-9197 or directly at 703-305-3028 / 703-308-6845 between the hours of 6 a.m. and 12 midnight, Monday through Friday, EST.
- Send e-mail correspondence for Patentin Software Program Help @ ebc@uspto.gov

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice MUST be returned with the response.*

SHELBY J VIGIL

Telephone: (703) 308-9140 EXT 224

**PART 2 - OFFICE COPY**

| U.S. APPLICATION NUMBER NO. | INTERNATIONAL APPLICATION NO. | ATTY. DOCKET NO. |
|-----------------------------|-------------------------------|------------------|
| 10/542,255                  | PCT/US04/00423                | 1368-8 PCT/US    |

## **EXHIBIT C**

Exhibit C

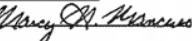
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|                                |   |                 |                 |
|--------------------------------|---|-----------------|-----------------|
| Applicant(s)                   | Matthew Pellegrini et al.   | Examiner:       | Unassigned      |
| Application No.:               | 10/542,255  | Group Art Unit: | Unassigned      |
| Confirmation No.:              | 5103  | Docket:         | 1368-8 PCT/US   |
| Filed:                         | July 15, 2005   |                 |                 |
| International Application No.: | PCT/US04/00423  | Int'l. Applic.  |                 |
|                                |   | Filing Date:    | January 9, 2004 |
| For:                           | METHODS AND SYSTEMS FOR THE IDENTIFICATION OF RNA REGULATORY SEQUENCES AND COMPOUNDS THAT MODULATE THEIR FUNCTION | Dated:          | May 23, 2006    |

Mail Stop PCT  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450

*I hereby certify this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to:*  
 Commissioner for Patents, P.O. Box 1450,  
 Alexandria, Virginia 22313-1450  
*On: May 23, 2006*

*Signed: Marcy H. Mancuso /*

RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER  
35 U.S.C. §371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE

Sir:

In response to the Notification of Missing Requirements mailed February 24, 2006, a response to which is due May 24, 2006 with a one month extension of time (Petition enclosed), for the above-identified case, Applicants submit the following:

100-1000

Applicant: Matthew Pellegrini et al.  
Application No.: 10/542,255  
Filing Date: July 15, 2005  
Docket No.: 1368-8 PCT/US  
Page 2

1. A Combined Declaration and Power of Attorney(s) signed by inventors of the above-identified invention, such Declaration identifying the application by the U.S. application number and filing date.
2. A copy of the Notification of Missing Requirements under 35 U.S.C. §371 in the United States Designated/Elected Office (DO/EO/US).
3. A computer readable copy of the Sequence Listing and a Statement regarding the Sequence Listing.

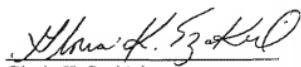
Please charge the Deposit Account No. 08-2461 in the amount of \$100.00 (\$35.00 for additional fees and \$65.00 for the surcharge fee for filing a late Declaration).

Please charge any deficiencies or credit any overpayment in these fees to Deposit Account No. 08-2461.

Should the Examiner have any questions regarding this submission, please contact the undersigned agent at the telephone number below.

06/01/2006 ATRAN1 00000120 082461 10542255  
01 FC:2617 55.00 DA

Respectfully submitted,

  
Gloria K. Szakiel  
Registration No.: 45,149  
Agent for Applicants

HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791  
(973) 331-1700



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Washington, DC 20231-1450  
[www.uspto.gov](http://www.uspto.gov)

|  |                       |   |
|--|-----------------------|---|
| U.S. APPLICATION NUMBER NO.  | FIRST NAMED APPLICANT | ATTY. DOCKET NO.  |
| 10/542,255   | Matthew C Pellegrini  | 1368-8 PCT/US   |
|  |                       | INTERNATIONAL APPLICATION NO.   |
|  |                       | PCT/US04/00423  |
| 23869<br>HOFFMANN & BARON, LLP<br>6900 JERICHO TURNPIKE<br>SYOSSET, NY 11791 | I.A. FILING DATE      | PRIORITY DATE   |
|  | 01/09/2004            | 01/17/2003  |
| MAR - 2 2006   |                       | CONFIRMATION NO. 5103   |
| 371 FORMALITIES LETTER   |                       |   |
|  |                       |  |
|  |                       | *OC000000018110117*   |

Date Mailed: 02/24/2006

**NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)**

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Indication of Small Entity Status
- Copy of the International Application filed on 07/15/2005
- Preliminary Amendments filed on 07/15/2005
- Information Disclosure Statements filed on 07/15/2005
- Biochemical Sequence Listing filed on 07/15/2005
- Small Entity Statement filed on 07/15/2005
- Request for Immediate Examination filed on 07/15/2005
- U.S. Basic National Fees filed on 07/15/2005



The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- To avoid abandonment, a surcharge (for late submission of filing fee, search fee, examination fee or oath or declaration) as set forth in 37 CFR 1.492(h) of \$65 for a small entity in compliance with 37 CFR 1.27, must be submitted with the missing items identified in this letter.

**SUMMARY OF FEES DUE:**

Total additional fees required for this application is \$-35 for a Small Entity:

• **\$65 Surcharge.**

- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

(A previous payment of \$100 will be applied to the additional fees indicated above.)

Applicant is cautioned that correction of the above items may cause the specification and drawings page count to exceed 100 pages. If the specification and drawings exceed 100 pages, applicant will need to submit the required application size fee.

For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:

- For Rules Interpretation, call (571) 272-0951
- For PatentIn Software Program Help, call Patent EBC at 1-866-217-9197 or directly at 703-305-3028 / 703-308-6845 between the hours of 6 a.m. and 12 midnight, Monday through Friday, EST.
- Send e-mail correspondence for PatentIn Software Program Help @ [ebc@uspto.gov](mailto:ebc@uspto.gov)

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice MUST be returned with the response.*

SHELBY J VIGIL

Telephone: (703) 308-9140 EXT 224

**PART 1 - ATTORNEY/APPLICANT COPY**

| U.S. APPLICATION NUMBER NO. | INTERNATIONAL APPLICATION NO. | ATTY. DOCKET NO. |
|-----------------------------|-------------------------------|------------------|
| 10/542,255                  | PCT/US04/00423                | 1368-8 PCT/US    |

**COMBINED DECLARATION AND POWER OF ATTORNEY**(ORIGINAL, DESIGN, NATIONAL STAGE OF PCT, SUPPLEMENTAL,  
DIVISIONAL, CONTINUATION OR CIP)

As a below named inventor, I hereby declare that:

**TYPE OF DECLARATION**

This declaration is of the following type: (check one)

|  |   |
|--|---|
| <input checked="" type="checkbox"/> Original | <input type="checkbox"/> National Stage PCT         |
| <input type="checkbox"/> Supplemental        | <input type="checkbox"/> Divisional                 |
| <input type="checkbox"/> Design              | <input type="checkbox"/> Continuation               |
|  | <input type="checkbox"/> Continuation-in-Part (CIP) |

**INVENTORSHIP IDENTIFICATION**

NOTE: If the inventors are each not the inventors of all the claims an explanation of the facts, including the ownership of all the claims at the time the last claimed invention was made, should be submitted.

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**METHODS AND SYSTEMS FOR THE IDENTIFICATION OF RNA REGULATORY SEQUENCES AND  
COMPOUNDS THAT MODULATE THEIR FUNCTION**

the specification of which: (complete (a), (b) or (c))

(a)  is attached hereto.

(b)  was filed on July 15, 2005 as  
 Serial No. 10/542,255 or  
 Express Mail No. \_\_\_\_\_, as Serial No. not yet known  
and was amended on \_\_\_\_\_. (if applicable)

(c)  was described and claimed in PCT International Application No. PCT/ \_\_\_\_\_  
filed on \_\_\_\_\_ and as amended under PCT Article 19 on \_\_\_\_\_. (if any)

**ACKNOWLEDGMENT OF REVIEW OF PAPERS AND DUTY OF CANDOR**

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above, and that the filing of said specification, if heretofore filed, was authorized by me.

I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

**CLAIM OF PRIORITY OF EARLIER FOREIGN APPLICATION(S) UNDER 35 U.S.C. §119(a)-(d)**

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate or of any PCT International application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT International application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed:

*(List prior foreign/PCT application(s) filed within 12 months (6 months for design) prior to this U.S. application.)*

*NOTE: Where item (c) is entered above and the International Application which designated the U.S. claimed priority check item (e), enter the details below and make the priority claim.*

| COUNTRY<br>(orPCT) | APPLICATION NO. | DATE OF FILING<br>(Day/Month/Year) | PRIORITY CLAIMED<br>UNDER 35 USC §119   |                             |
|--------------------|-----------------|------------------------------------|---|-----------------------------|
| PCT                | 2004/000423     | 09/January/2004                    | <input checked="" type="checkbox"/> YES | <input type="checkbox"/> NO |
|                    |                 |                                    | <input type="checkbox"/> YES            | <input type="checkbox"/> NO |

**CLAIM FOR BENEFIT OF PRIOR U.S. PROVISIONAL APPLICATION(S) UNDER 35 U.S.C. §119(e)**

I hereby claim the benefit under Title 35, United States Code, §119(e) of any United States provisional application(s) listed below:

*(List prior U.S. provisional applications.)*

| PROVISIONAL APPLICATION NO. | FILING DATE<br>(Day/Month/Year) |
|-----------------------------|---------------------------------|
| 60/441,028                  | January 17, 2003                |
|                             |                                 |

**CLAIM FOR BENEFIT OF EARLIER U.S./PCT APPLICATION(S) UNDER 35 U.S.C. 120**

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) or PCT International application(s) designating the United States of America that is/are listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in such prior application(s) in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a) which occurred between the filing date of the prior application(s) and the national or PCT International filing date of this application:

*(List prior U.S. applications or PCT International applications designating the U.S. for benefit under 35 U.S.C. §120.)*

**U.S. APPLICATIONS**

**STATUS (Check One)**

| U.S. SERIAL NO. | U.S. FILING DATE<br>(Day/Month/Year) | Patented                 | Pending                  | Abandoned                |
|-----------------|--------------------------------------|--------------------------|--------------------------|--------------------------|
| 0/              |                                      | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 0/              |                                      | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |

**PCT APPLICATIONS DESIGNATING THE U.S.**

**STATUS (Check One)**

| PCT APPLN. NO. | PCT FILING DATE<br>(Day/Month/Year) | U.S. SERIAL NOS<br>ASSIGNED (If any) | Patented                 | Pending                  | Abandoned                |
|----------------|-------------------------------------|--------------------------------------|--------------------------|--------------------------|--------------------------|
| PCT/           |                                     |                                      | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| PCT/           |                                     |                                      | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |

**35 USC 119 PRIORITY CLAIM, IF ANY, FOR ABOVE LISTED U.S./PCT APPLICATIONS**

| PRIORITY<br>APPLICATION NO. | PRIORITY<br>COUNTRY | FILING DATE<br>(Day/Month/Year) | ISSUE DATE<br>(Day/Month/Year) |
|-----------------------------|---------------------|---------------------------------|--------------------------------|
|                             |                     |                                 |                                |
|                             |                     |                                 |                                |

**POWER OF ATTORNEY**

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) at Customer Number 23869 to prosecute this application and transact all business in the Patent and Trademark Office in connection therewith.

PLEASE SEND CORRESPONDENCE TO:

Daniel A. Scola, Jr.  
HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, NY 11791

PLEASE DIRECT TELEPHONE CALLS TO:

Gloria K. Szakiel  
(973) 331-1700

#### DECLARATION

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

#### SIGNATURE(S)

|                                     |   |
|-------------------------------------|---|
| Full Name of First Inventor:        | Matthew C. Pellegrini                               |
| Country of Citizenship:             | USA   |
| Residence Address:                  | 76 Autumn Ridge Drive, Bedminster, New Jersey 07921 |
| Post Office Address:                | Same as above                                       |
| Date:                               | 4/30/06   |
|                                     | Inventor's signature                                |
|                                     | <i>Matthew C. Pellegrini</i>                        |
| Full Name of Second Joint Inventor: | Christopher R. Trotta                               |
| Country of Citizenship:             | USA   |
| Residence Address:                  | 198 Scobee Lane, Somerset, New Jersey 08873         |
| Post Office Address:                | Same as above                                       |
| Date:                               | 5-9-2006  |
|                                     | Inventor's signature                                |
|                                     | <i>Chris A.</i>                                     |
| Full Name of Third Joint Inventor:  | Shah I. Huq   |
| Country of Citizenship:             | USA   |
| Residence Address:                  | 42 Florence Street, Edison, New Jersey 08817        |
| Post Office Address:                | Same as above                                       |
| Date:                               | 5-9-2006  |
|                                     | Inventor's signature                                |
|                                     | <i>Shah I. Huq</i>                                  |

NOTE: All above spaces identifying inventors must be completed or deleted before any inventor executes this application

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Matthew Pellegrini et al. Examiner: Unassigned  
Application No.: 10/542,255 Group Art Unit: Unassigned  
Confirmation No.: 5103 Attorney Docket No.: 1368-8 PCT/US  
Filing Date: July 15, 2005  
International Appl. No.: PCT/US04/00423 International Filing Date: January 9, 2004  
Title: METHODS AND SYSTEMS Dated: May 23, 2006  
FOR THE IDENTIFICATION  
OF RNA REGULATORY  
SEQUENCES AND  
COMPOUNDS THAT  
MODULATE THEIR  
FUNCTION

Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

*I hereby certify this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on May 23, 2006.*

*Signed: Marcy H. Mancuso / *

**PETITION FOR EXTENSION OF TIME**

Sir:

Pursuant to 37 C.F.R. 1.136(a), an extension of time of

|              |                          |           |              |                                     |          |
|--------------|--------------------------|-----------|--------------|-------------------------------------|----------|
| one month    | <input type="checkbox"/> | \$ 120.00 | Small Entity | <input checked="" type="checkbox"/> | \$ 60.00 |
| two months   | <input type="checkbox"/> | 450.00    |              | <input type="checkbox"/>            | 225.00   |
| three months | <input type="checkbox"/> | 1,020.00  |              | <input type="checkbox"/>            | 510.00   |
| four months  | <input type="checkbox"/> | 1,590.00  |              | <input type="checkbox"/>            | 795.00   |
| five months  | <input type="checkbox"/> | 2,160.00  |              | <input type="checkbox"/>            | 1,080.00 |

is hereby requested to

respond to the Official Action mailed February 24, 2006.

file a Notice of Appeal \_\_\_\_\_

file an Appeal Brief now due \_\_\_\_\_

other (specify) \_\_\_\_\_

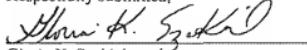
The requisite fee pursuant to 37 C.F.R. §1.17 is enclosed by check.

The Commissioner is hereby authorized to charge our Deposit Account No. 08-2461. duplicate copy of this sheet is attached.

06/01/2006 ATRAN1 00000120 082461 10542255  
02 FC:2251 60.00 DA

If any additional fees are due or any overpayment has been made, please charge our Deposit Account No. 08-2461 or credit our Deposit Account for such sum.

Respectfully submitted,

  
Gloria K. Szakiel  
Registration No. 45,149

Hoffmann & Baron, LLP  
6900 Jericho Turnpike  
Syosset, NY 11791  
(973) 331-1700

## **EXHIBIT D**



## UNITED STATES PATENT AND TRADEMARK OFFICE

*Exhibit D*

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

|  |                       |                               |
|--|-----------------------|-------------------------------|
| U.S. APPLICATION NUMBER NO   | FIRST NAMED APPLICANT | ATTY. DOCKET NO.              |
| 10/542,255   | Matthew C Pellegrini  | 1368-8 PCT/US                 |
|  |                       | INTERNATIONAL APPLICATION NO. |
|  |                       | PCT/US04/00423                |
| IA. FILING DATE  |                       | PRIORITY DATE                 |
| 01/09/2004   |                       | 01/17/2003                    |
| <b>CONFIRMATION NO. 5103</b>   |                       |                               |
| <b>371 FORMALITIES LETTER</b>  |                       |                               |
| <br>*OC000000022855406* |                       |                               |

Date Mailed: 03/13/2007

### NOTIFICATION OF DEFECTIVE RESPONSE

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495)

- Indication of Small Entity Status
- Priority Document
- Copy of the International Application filed on 07/15/2005
- Preliminary Amendments filed on 07/15/2005
- Information Disclosure Statements filed on 07/15/2005
- Oath or Declaration filed on 05/25/2006
- Biochemical Sequence Listing filed on 07/15/2005
- Small Entity Statement filed on 07/15/2005
- Request for Immediate Examination filed on 07/15/2005
- U.S. Basic National Fees filed on 07/15/2005

Applicant's response filed 05/25/2006 is hereby acknowledged. The following requirements set forth in the NOTIFICATION OF MISSING REQUIREMENTS mailed 02/24/2006 have not been completed.

- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

Applicant is required to complete the response within a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements, whichever is the longer. No extension of this time limit may be granted under 37 CFR 1.136, but the period for response set in the Notification of Missing Requirements may be extended under

**37 CFR 1.136(a).**

Applicant is cautioned that correction of the above items may cause the specification and drawings page count to exceed 100 pages. If the specification and drawings exceed 100 pages, applicant will need to submit the required application size fee.

For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:

- For Rules Interpretation, call (571) 272-0951
- For Patentin Software Program Help, call Patent EBC at 1-866-217-9197 or directly at 703-305-3028 / 703-308-6845 between the hours of 6 a.m. and 12 midnight, Monday through Friday, EST.
- Send e-mail correspondence for Patentin Software Program Help @ [ebc@uspto.gov](mailto:ebc@uspto.gov)

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web.

<https://sportal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

For more information about EFS-Web please call the USPTO Electronic Business Center at 1-866-217-9197 or visit our website at <http://www.uspto.gov/ebc>.

If you are not using EFS-Web to submit your reply, you must include a copy of this notice.

SHELBY J VIGIL

---

Telephone: (703) 308-9140 EXT 224

**PART 2 - OFFICE COPY**

---

| U.S. APPLICATION NUMBER NO. | INTERNATIONAL APPLICATION NO. | ATTY. DOCKET NO. |
|-----------------------------|-------------------------------|------------------|
| 10/542,255                  | PCT/US04/00423                | 1368-8 PCT/US    |

FORM PCT/DO/EO/916 (371 Formalities Notice)

## **EXHIBIT E**

Exhibit E

Applicant(s): Pellegrini et al.  
Appl'n. Serial No: 10/542,255  
Examiner: Unassigned  
Title: METHODS AND SYSTEMS FOR THE IDENTIFICATION OF RNA REGULATORY  
SEQUENCES AND COMPOUNDS THAT MODULATE THEIR FUNCTION  
Confirmation No.: 5103  
Certificate of Mailing Dated: April 12, 2007  
Attorney Docket: 1368-8 PCT/US

The U. S. Patent and Trademark Office date stamp will acknowledge receipt of the following:

- (X) Response to Notification of Defective Response (2 pages);
- (X) Computer-Readable Form of Sequence Listing (1 disk);
- (X) Statement Regarding Sequence Listing (1 page); and
- (X) Return Receipt Postcard

GKS/mhm (0008)

Applicant(s): Pellegrini et al.  
Appl'n. Serial No: 10/542,255  
Examiner: Unassigned  
Title: METHODS AND SYSTEMS FOR THE IDENTIFICATION OF RNA REGULATORY  
SEQUENCES AND COMPOUNDS THAT MODULATE THEIR FUNCTION  
Confirmation No.: 5103  
Certificate of Mailing Dated: April 12, 2007  
Attorney Docket: 1368-8 PCT/US

The U. S. Patent and Trademark Office date stamp will acknowledge receipt of the following:

- (X) Response to Notification of Defective Response (2 pages);
- (X) Computer-Readable Form of Sequence Listing (1 disk);
- (X) Statement Regarding Sequence Listing (1 page); and
- (X) Return Receipt Postcard

IAP6 Rec'd PCT/PTO 16 APR 2007

GKS/mhm (0008)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|                                |   |                           |                 |
|--------------------------------|---|---------------------------|-----------------|
| Applicant(s)                   | Matthew Pellegrini et al.   | Examiner:                 | Unassigned      |
| Application No.:               | 10/542,255  | Group Art Unit:           | Unassigned      |
| Confirmation No.:              | 5103  | Docket:                   | 1368-8 PCT/US   |
| Filed:                         | July 15, 2005   |                           |                 |
| International Application No.: | PCT/US04/00423  | Int'l. Appl. Filing Date: | January 9, 2004 |
| For:                           | METHODS AND SYSTEMS FOR THE IDENTIFICATION OF RNA REGULATORY SEQUENCES AND COMPOUNDS THAT MODULATE THEIR FUNCTION | Dated:                    | April 12, 2007  |

Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

*I hereby certify this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to:*  
Commissioner for Patents, P.O. Box 1450,  
Alexandria, Virginia 22313-1450

*On: April 12, 2007*

*Signed: Marcy H. Mancuso / *

RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE

Sir:

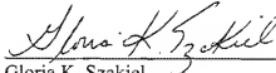
This is in response to the Notification of Defective Response, a reply to which is due April 13, 2007. This Notification indicates that a computer-readable form of the sequence listing must be submitted. In response to the Notification, Applicants are submitting herewith the following items:

- (1) a computer-readable form of the sequence listing; and
- (2) a Statement regarding the content of the sequence listing formation.

Applicant: Matthew Pellegrini et al.  
Application No.: 10/542,255  
Filing Date: July 15, 2005  
Docket No.: 1368-8 PCT/US  
Page 2

Applicants submit that the application is now in condition for examination. Should the Examiner have any questions concerning this Response, he or she is respectfully invited to contact the undersigned agent at the telephone number set forth below.

Respectfully submitted,

  
\_\_\_\_\_  
Gloria K. Szakiel  
Registration No.: 45,149  
Agent for Applicants

HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791  
(973) 331-1700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) Matthew Pellegrini et al. Examiner: Unassigned  
Application No.: 10/542,255 Group Art Unit: Unassigned  
Confirmation No.: 5103 Docket: 1368-8 PCT/US  
Filed: July 15, 2005  
International Application No.: PCT/US04/00423 Int'l. Applic. Filing Date: January 9, 2004  
For: METHODS AND SYSTEMS FOR THE IDENTIFICATION OF RNA  
REGULATORY SEQUENCES AND COMPOUNDS THAT MODULATE THEIR FUNCTION

Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

*I hereby certify this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to:*  
Commissioner for Patents, P.O. Box 1450,  
Alexandria, Virginia 22313-1450

*On: April 12, 2007*

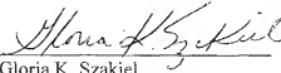
*Signed. Marcy H. Mancuso* 

STATEMENT REGARDING SEQUENCE LISTING

Sir:

Applicants are submitting herewith a Sequence Listing in computer-readable form. The content of the sequence listing information recorded in computer readable form is identical to the written sequence listing filed with the application and includes no new matter.

Respectfully submitted,

  
Gloria K. Szakiel  
Registration No.: 45,149  
Agent for Applicants

HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791  
(973) 331-1700

# Floppy Disk/CD Mailer

Medium Type: diskette (3.5 in 1.44 mb,  
ASCII Text)  
Operating System: NT/2000  
Applicant(s): Pellegrini et al  
Application No: 10/542,255  
Diskette made: April 12, 2007  
Computer Readable Form (CRF)  
File Name: 1368-8 PCT US Sequence Listing ST25  
Docket No. 1368-8 PCT/US  
Title: METHODS AND SYSTEMS FOR THE  
IDENTIFICATION OF RNA REGULATORY  
SEQUENCES AND COMPOUNDS THAT  
MODULATE THEIR FUNCTION

SEQUENCE LISTING DISK

**DO NOT BEND OR FOLD  
AVOID EXPOSURE TO ALL MAGNETIC FIELDS**